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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,806	03/04/2002	Saeko Kurachi	111204	1604
25944	7590	02/15/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			JOHNSON, CHRISTINA ANN	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,806	Applicant(s) KURACHI, SAEKO	
	Examiner Christina Johnson	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-13,17-25,29-34 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) 24,25,29-34 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-13,17-23 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112, First Paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-2, 6-13, and 17-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 9, 11, and 22 recite the limitation "the carrier comprising pores having a pore diameter in the range of from 0.55 nanometers (nm) to 0.65 nanometers (nm)." It is the position of the examiner that the specification as originally filed does not provide support for this limitation. The pore range recited is inconsistent with the description in the specification at [0045]-[0046], which requires that that carrier have a maximum pore diameter of 0.55-0.65 nm. This is not the same as requiring the carrier to have a particular pore size range. Also, it is not clear that the two carriers taught as suitable, specifically ferrierite and ZSM-5, would meet the pore size range instantly claimed.

Claim Rejections - 35 USC § 112, Second Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-2, 6-13, and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 9, 11, and 22 recite the limitation "the carrier comprising pores having a pore diameter in the range of from 0.55 nanometers (nm) to 0.65 nanometers (nm)."

This limitation renders the claims indefinite because it is inconsistent with the specification, which does not describe the carrier as having to possess this size range, only "provided with a carrier having the maximum pore diameter of 0.55 to 0.65 nm," (which description in itself is indefinite). Also, it is not clear that ferrierite would include pores of this size range as it has pores of 0.43X0.55 nm in size. It is not clear whether ZSM-5 is considered to fall within the scope of claims 11-13 and 17-23, although ZSM-5 is described in the specification as an example of a carrier which has the maximum pore diameter. For the purposes of search and examination, the claims have been examined with the broadest reasonable interpretation consistent with the specification and are considered to include ZSM-5 and ferrierite.

To overcome this rejection it is suggested that applicant delete the phrase "the carrier comprising pores having a pore diameter in a range of from 0.55 nm to 0.65 nm" and replace with a specific recitation of the zeolites described as suitable in the specification, i.e. ferrierite and/or ZSM-5. Applicant is advised that merely deleting the recitation and not adding in the specific zeolite(s) (i.e. resulting in only claiming a maximum pore diameter of 65 nm) would subject the claims to a rejection over small pore zeolites such as zeolite A, discussed in the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 6-8, 11-13, 17-19, 22-23, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakano et al.

Nakano et al. (US 5,208,198) discloses a catalyst composition comprising (i) a zeolite and (ii) incorporated therein (a) cobalt, (b) an alkaline earth metal, and (c) platinum and/or manganese (column 2, lines 55-65). Suitable zeolites include ferrierite and ZSM-5 (column 3, lines 10-2). The zeolites taught by the reference would meet the pore sizes instantly claimed.

With respect to claim 1, the “consisting essentially of” language in the claims is noted. The term limits the claim to the specified ingredients and those that do not affect the basic and novel characteristics of a composition. *Ex parte Davis et al.*, 80 USPQ 448. When applicant contends that modifying or additional components in the reference composition are excluded by the recitation “consisting essentially of,” applicant has the burden of showing the basic and novel characteristics of the claimed composition, i.e. a showing that the introduction of these components would materially change the characteristics of applicant’s composition. *In re De Lajarte*, 143 USPQ 256.

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The process of making limitations in claims 6-8 and 17-19 are noted. However, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

The intended use limitations recited throughout the claims are noted by the examiner. While intended use recitations cannot entirely be disregarded, in composition and article claims, the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention over the prior art. *In re Casey*, 370 USPQ 235 and *In re Otto*, 312 USPQ 458. It is the position of the examiner that the prior art structure is capable of performing the intended use and therefore meets the instant claims.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Nakano et al.

8. Claims 11-13, 17-19, 22-23, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Onodera et al.

Onodera et al. (US 4,485,185) discloses a catalyst composition comprising: (i) a crystalline zeolite such as ZSM-5 and ZSM-35 and (ii) at least two metals which are (a) platinum and (b) an additional metal such as chromium (column 3, lines 5-15). The zeolites taught by the reference would meet the pore sizes instantly claimed.

With respect to claim 1, the "consisting essentially of" language in the claims is noted. The term limits the claim to the specified ingredients and those that do not affect

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the basic and novel characteristics of a composition. *Ex parte Davis et al.*, 80 USPQ 448. When applicant contends that modifying or additional components in the reference composition are excluded by the recitation "consisting essentially of," applicant has the burden of showing the basic and novel characteristics of the claimed composition, i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. *In re De Lajarte*, 143 USPQ 256.

The process of making limitations in claims 17-19 are noted. However, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

The intended use limitations recited throughout the claims are noted by the examiner. While intended use recitations cannot entirely be disregarded, in composition and article claims, the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention over the prior art. *In re Casey*, 370 USPQ 235 and *In re Otto*, 312 USPQ 458. It is the position of the examiner that the prior art structure is capable of performing the intended use and therefore meets the instant claims.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Onodera et al.

Allowable Subject Matter

9. The indicated allowability of claims 9-10 is withdrawn in light of the amendments to these claims which resulted in a rejection under 35 USC 112, first paragraph.

Response to Arguments

10. Applicant's arguments with respect to claims 1-2, 6-13, 17-23, and 41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Johnson whose telephone number is (571) 272-1176. The examiner can normally be reached on Monday-Friday, 7:30-5, with Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Christina Johnson
Patent Examiner
Art Unit 1725
2/10/05

CAJ
February 10, 2005